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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/606,137

06/25/2003

David Vincent Zyzak

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3971

27752

7590

07/28/2006

THE PROCTER & GAMBLE COMPANY
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EXAMINER

HENDRICKS, KEITH D

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,137

Applicant(s)

ZYZAK ET AL.

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 42-44, 47, 48 and 50-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 42-44, 47, 48 and 50-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/14/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

i) Claims 11-32 and 45-50 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the August 2005 response, applicant amended the claims to generally read "... wherein the level of acrylamide [or asparagine] in said food material is reduced by at least about 10% from the level in the food material in a previous condition." The phrase "from the level in the food material in a previous condition" has been added; however, applicant has not pointed out where in the specification this phrase actually finds support. This is not apparent from the specification, and furthermore, the phrase appears to broaden the scope of the original description and claims.

Applicant has not responded to the rejection, and thus it is maintained for the reasons of record. Note that there were and are two (i and ii) rejections under 35 U.S.C. 112.

ii) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-32 and 45-50 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As previously addressed on the record, the term "reduced", in the product/article claims, is a relative term which renders the claims indefinite. The term "reduced" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

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Applicant's arguments filed May 09, 2006 have been fully considered but they are not persuasive. At page 9 of the response, applicant refers to the specification and examples for support and definition of the rejected phrase. Applicant states that "both control products and treated products are tested", and that "the treated products show substantially lower levels of acrylamide than do the control products." However, given this disclosure, it is unclear as to how the "control products" translate to "the food material in a previous condition." If the control products are different than the treated products (i.e. they are untreated and thus not simply in a "previous condition"), then they cannot be considered to indicate the food material of the instantly-claimed phrase. If applicant intends the claim to indicate some comparison between the current food material and a control of the same food material, then applicant may wish to (a) ensure support for the phrasing within the specification, and (b) claim this language as part of the invention. It is noted, however, that no treatment or method steps are recited in many of the rejected claims. Again, applicant is required to present evidence of support for this phrase, or cancel the improperly added subject matter.

However, more importantly, applicant's arguments do not address the core issue of the rejection, which has been clearly and repeatedly set forth on the record. For applicant's clarification, the rejection is again set forth below.

Initially, it is important to note that acrylamide is not originally present in food materials such as the natural starchy foods, and thus if it never existed, it cannot be "reduced" by at least about 10% from the level in the food material in a previous condition."

Secondly, regarding the reference to reducing the amount of asparagine "from the level in the food material in a previous condition," this is indefinite as it does not provide a positive and definite frame of reference by which the skilled artisan would be able to ascertain the metes and bounds of the claimed invention. It is unclear if the amended phrase refers to a single minute prior to the time it is measured, or a week, or perhaps during some growth phase of the food material. As previously stated on the record, the definition of the term "reduced" is not in question. Applicant has attempted to supplement the definition of the term "reduced" with the added phrase such that one skilled in the art might recognize and understand the metes and bounds of the claimed invention, yet the context of the claims and the term "reduced" is still not clear, in light of the specification. While the specification may be useful to clarify or support the claims, it is improper to rely upon the specification to provide the role of distinctly claiming the subject matter which the applicant regards as their invention. The essential conditions must be provided within the context of a claim, in order to establish the necessary properties and in order to understand how the term "reduced" applies in this context. A product, as it stands in its current state,

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cannot simply be “reduced”, without reference to a standard (for example, as compared to a control sample processed in the same manner but without the asparaginase addition).

Further, as an example, if a simple box contained five beans, it would be impossible to discern whether this amount was “reduced” from a previous higher number of beans, or even “increased” from a lower number, or had always possessed five beans. A simple label of “reduced” would not be sufficient to describe the box which originally had five beans, without proper context (and also would not differ from another box which always possessed five beans, nor one which originally had seven and where two were removed). The same principle applies to a final food product, including potato products, as instantly claimed. Thus similarly, if two distinct cooked potato crisps each contain 350 ppb of acrylamide, where one contained said amount from a control process and one had been processed according to the invention, given this data alone, it would be impossible for one skilled in the art to determine which one had been “reduced” from a previously higher amount, and which one was at this level from some other means.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21, 42-44, 47-48 and 50-63 (all pending) are rejected under 35 U.S.C. 103(a) as being unpatentable over Elder et al. (Pub. No. US 2004/0058054). The reference and rejection are taken as cited in a previous Office action.

In response to the rejection, applicant has previously provided a Suggestion for Interference, pursuant to 37 C.F.R. § 41.202. This was addressed previously on the record, and the position of the Office stands with regard to said issue. See the Office action of December 09, 2005.

In the response of May 09, 2006, applicant states that, due to their earliest effective filing date of September 20, 2002, the “rejection is based on an application [Elder et al.] having a filing date only one day before”, namely September 19, 2002.

This is not deemed persuasive. Initially, it is noted that the current rejection is made under 35 U.S.C. 103(a), based upon a reference eligible under 35 U.S.C. 102(e), which states in part that a person

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shall be entitled to a patent unless "the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent." Whether a reference meets the requirements of the statute by one day, or by two years, applicant must still take the necessary measures to remove the reference as prior art, and/or to persuasively argue that the reference does not render the instant claims obvious. For example, as previously stated on the record, applicant has not submitted arguments, declarations and/or evidence to overcome the rejection at hand, and thus it remains for the reasons of record. Such evidence may be in the form of a properly executed declaration under 37 CFR 1.131 or 1.132. As neither of these have occurred, the rejection is properly maintained. The examiner is not in a position to randomly pursue any measures of interference proceedings while the rejection is still properly maintained.

****** It is noted that the Elder application has now issued as US PAT 7,037,540, on May 02, 2006.

At the time of this Office action, the current application is not in condition for allowance, as all issues have not been resolved.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KEITH HENDRICKS
PRIMARY EXAMINER